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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,043	06/26/2001	Dale F. McIntyre	83013F-P	1730

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EXAMINER	
FLEURANTIN, JEAN B	

ART UNIT	PAPER NUMBER
2162	

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/892,043	MCINTYRE, DALE F.	
	Examiner	Art Unit	
	JEAN B. FLEURANTIN	2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 April 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This is in response to Applicant(s) arguments filed on 28 April 2005.

2. Claims 1-24 remain pending for examination.

Response to Applicant' Remarks

3. Applicant's arguments filed 09 December 2004 have been fully considered but they are not persuasive for the following reasons, see sections A and B.

Claim Rejections - 35 USC § 103

A. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8, 12-20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,321,231 issued to Jebens et al. ("hereinafter Jebens") and US Patent No. 5,737,491 issued to Allen et al. (hereinafter "Allen") and further in view of US Patent No. 6,381,636 issued to Cromer et al., (hereinafter "Cromer").

As per claims 1, 12 and 24, Jebens discloses "a method comprising the steps of:

"automatically initiating the obtaining of instructions stored on a user computer over said communication network by a service provider" as a means for receiving instructions from the first user directing that the electronic file be delivered to a second user, and automatically routing the electronic file, (see col. 3, lines 5-10), and further, in column 18, line 63 to column 19, line 10, Jebens discloses the hot-folder system automatically moves the files to a processing queue and then compresses the file per predetermined compression settings, in which the communication portion of the local computer then establishes a connection with the host site. Jebens does not explicitly disclose said instructions being associated with a digital media file stored on said user computer; and implementing said instructions with respect to said associated digital image file. However, Allen discloses a memory for storing digital images produced by the image sensor in digital image files, the digital image files having associated information for controlling a remote image fulfillment server, (see Allen col. 1, lines 36-45). It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the combined teachings of Jebens and Allen with said instructions being associated with a digital media file stored on said user computer; and implementing said instructions with respect to said associated digital image file. Such modification would allow the teachings of Jebens and Allen to improve the accuracy and the reliability of the method and system for managing images over a communication network using user provider instructions, and to provide a choice of different communication relay services, (see col. 1, lines 59-60). While, Jebens and Allen disclose the claimed subject matter except the claimed an automatic service over a

communication network to a user based on stored instructions by a user on a user computer. However, Cromer discloses the claimed a server computer system to remotely access asset information stored within a client computer system coupled to the server utilizing a network, in which asset information is stored within each client which includes information identifying software components of the particular client (see Cromer col. 3, lines 16-37) and column 2, lines 15-26. It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the combined teachings of Jebens and Allen and Cromer with claimed an automatic service over a communication network to a user based on stored instructions by a user on a user computer. Such modification would allow the teachings of Jebens and Allen and Cromer to provide a path to allow software running on client to access application integrated circuit, (see Cromer col. 5, lines 65-66).

As per claims 2 and 14, Jebens discloses "where said instruction comprises instructions relating the sale of rights to use and/or reproduce said image", (see col. 9, lines 47-51).

As per claims 3 and 15, Jebens discloses "where said instruction comprises the purchase, use, or sale of an item displayed in said image" as invoices are developed by reference to the activities logged in the activity log during a pre-defined billing period, predefined ones of the events are assigned a charge by the system, all of the charges

for a given image provider user are preferably automatically organized and displayed in an invoice, (see col. 17, lines 43-51).

As per claims 4 and 16, Jebens discloses "said instruction was entered on a form, (see col. 17, lines 43-46).

As per claims 5 and 17, Jebens discloses "said form is displayed in association with said image", (see col. 20, line 60 to col. 21, line 6).

As per claims 6 and 18, the limitations of claims 6 and 18 are rejected in the analysis of claim 1, and these claims are rejected on that basis.

As per claims 7 and 19, Jebens discloses "the service provider recognizes that a digital image file has been identified for a service during a routine communication interval" as the low-resolution images downloaded to the agency preferably have a relatively low bandwidth communication requirement and can be transmitted in a relatively short amount of time, (see col. 5, lines 24-35).

As per claims 8 and 20, Jebens discloses "an electronic form is provided to the user by service provider in response to discovering of the identified digital image file" as displays the status of any recently place work orders, (see figure I OF col. 21, lines 46-53).

As per claim 13, in addition to claim 1, Jebens further discloses "said associated digital image file representing an image" as a means for translating the digital images received by the system into a file format defined by the first asset provider user before storing the digital images in the storage device, (see col. 27, lines 44-47).

4. Claims 9-11 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable US Patent No. 6,321,231 issued to Jebens et al. ("hereinafter Jebens") and US Patent No. 5,737,491 issued to Allen et al. (hereinafter "Allen") and US Patent No. 6,381,636 issued to Cromer et al., (hereinafter "Cromer") as applied to claims 2 and 14 above, and further in view of US Patent issued to Narayen et al. (hereinafter "Narayen").

As per claims 9-11 and 21-23, Jebens and Allen and Cromer disclose the claimed subject mater except the claimed a metadata field of the identified digital image file is modified to reflect the data added to the electronic form; wherein the metadata field is provided in said service provider computer; wherein the metadata field is provided in said user computer. However, Narayen discloses the claimed a data object is created for each digital image and is stored in a database, this storage is in addition to the storage of the original file for the original image on a file storage device, the storage in the database typically is performed by a picture management system which is typically a separate piece of software which creates and stores the data object for each digital image and also which maintains the database (see Narayen col. 6, line 28 to col. 7, line

13). It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the combined teachings of Jebens and Allen and Cromer and Narayen with a metadata field of the identified digital image file. Such modification would allow the teachings of Jebens and Allen and Cromer and Narayen to provide a user on a client computer system to create a media container which contains digital media and publish this media container with its digital media onto the Internet for other computer systems to be able to view the media container with its digital media, (see Narayen col. 7, lines 28-34).

B. Applicant(s) stated, page 3, paragraph 2, that "Applicant would like to point out that the passage to which the Examiner refers to at column 3, lines 5-10 is directed to the situation where instructions are provided by the user 12 that provide instructions for a host 10 for delivering of files to an identified second user such as supplier 16. See column 21, lines 62-67 and column 22, lines 36-42. It can be clearly seen that it is the user that initiates the order to the host site 10 whereupon the host site would then, in response, prepare a job order and sends it to the appropriate recipient." It is respectfully submitted that Jebens and Allen substantially disclose the claimed subject matter except the claimed an automatic service over a communication network to a user based on stored instructions by a user on a user computer. Cromer discloses the claimed a server computer system to remotely access asset information stored within a client computer system coupled to the server utilizing a network, in which asset information is stored within each client which includes information identifying software components of

the particular client (see Cromer col. 3, lines 16-37) and column 2, lines 15-26. It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the combined teachings of Jebens and Allen and Cromer with claimed an automatic service over a communication network to a user based on stored instructions by a user on a user computer. Such a combination would allow the teachings of Jebens and Allen and Cromer to provide a path to allow software running on client to access application integrated circuit (see Cromer col. 5, lines 65-66).

In response to applicant's argument, page 3, paragraph 1, that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the service provider in response to the instructions stored on the local computer, **takes the appropriate action with regard** to the digital image file stored on the local computer, i.e. user computer. This is not taught or suggested in Jebens.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument, page 3, paragraph 2, that "the Allen et al. reference that the camera initiates the communication. This is in complete contradiction to the claimed invention." The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or

all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument, page 3, paragraphs 3 and 4, that "there is no teaching or suggestion or motivation as to why one would combine the teachings of Allen et al. with the Jebens et al. reference." The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Jebens and Allen disclose the claimed subject matter except the claimed an automatic service over a communication network to a user based on stored instructions by a user on a user computer. However, Cromer discloses the claimed a server computer system to remotely access asset information stored within a client computer system coupled to the server utilizing a network, in which asset information is stored within each client which includes information identifying software components of the particular client (see Cromer col. 3, lines 16-37) and column 2, lines 15-26. It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the combined teachings of Jebens and Allen and Cromer with claimed an automatic service over a communication network to a user based on stored instructions

by a user on a user computer. Such modification would allow the teachings of Jebens and Allen and Cromer to provide a path to allow software running on client to access application integrated circuit, (see Cromer col. 5, lines 65-66).

MPEP 2111 Claim Interpretation; Broadest Reasonable Interpretation

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification" Applicant always has the opportunity to amend the claims during prosecussion and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969). The court found that applicant was advocating ... the impermissible importation of subject matter from the specification into the claim. See also In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definition or otherwise that may be afforded by the written description contained in application's specification.").

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

For the above reasons, it is believed that the last Office Action was proper.

Conclusion

4. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

CONTACT INFORMATION

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEAN B. FLEURANTIN whose telephone number is 571 – 272-4035. The examiner can normally be reached on 7:05 to 4:35.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 571 – 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jean Bolte Fleurantin

Patent Examiner

Technology Center 2100

July 07, 2005

SHAHID ALAM
PRIMARY EXAMINER